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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/730,219 | 12/05/2000 | Ghassan Chidiac | YOR920000746US1 | 9167 |

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| EXAMINER | |
|---|---|
| SANTOS, PATRICK J D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2161 | |

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/730,219 | CHIDIAC ET AL. | |
| | Examiner | Art Unit | |
| | Patrick J Santos | 2161 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 16 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation of 11 on next page.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 11.

**REPLY TO APPLICANT'S AFTER FINAL REMARKS**

MPEP 2131 discloses that, "To anticipate a claim, the reference must teach every element of the claim." Applicant correctly points out cut-and-paste errors in Examiner's Final Office Action. However, Examiner maintains rejections of Applicant's claims under 102(b) as being anticipated by Ogawa et al. (U.S. Patent 5,608,874) and under 102(e) as being anticipated by Probert et al. (U.S. Patent 6,549,918). Since accounting for the cut-and-paste errors pointed out by Applicant does not change Ogawa and Probert teach every element of the claims rejected under 102(b) and 102(e) respectively, Ogawa and Probert both anticipate applicant's claims, and the basis for rejecting applicant's claims remains the same as in the Final Office Action.

A. Ogawa Covers The Limitations Erroneously Omitted In The Final Office Action.

Applicant's remarks regarding the 102(b) rejection address the limitation "determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation" (underlining indicates amendatory language omitted from Final Office Action).

Applicant argues that "Ogawa et al. convert the target data file to a universal or common format suitable for convenient translation" (Remarks: p. 2, lns. 7-9). Since the data of the target data file can be translated to the universal or common format, that universal or common format is a file format of said data file. Furthermore, the universal or common format suitable for convenient translation reads on being optimal for translation. Thus the universal or common format, as pointed out by applicant, reads on an "optimal file format of said data file."

Regarding "a plurality of stored file formats of said data file", as pointed out in the Response to Arguments in the Final Office Action, "... in fact, Ogawa '874 discloses storage of multiple file formats, as embodied in the translation modules, and discloses selection of a translation module" (Final Office Action: p. 9, lns. 6-8). Multiple translation formats, which take advantage of the universal or common format, but result in a translation of the data file to a requested format, where each format is a potential format of said data file, reads on "a plurality of stored file formats of said data file."

Finally, regarding Claim 23, Applicant states that no additional passage was recited for the phrase, "for determining an optimal one of a plurality of file formats for use in performing said translation" (Remarks: p. 3, lns. 1-2). In the Final Office Action, Examiner cited, "Ogawa '874: col. 33, ln. 48 to col. 34, ln. 64). Since this citation includes Ogawa '874: col. 34, lns. 60-64, which were used to reject similar claim language in Claim 1 as per the preceding three paragraphs, Examiner did not add any additional passages.

B. Probert Covers The Limitations Erroneously Omitted In The Final Office Action.

Probert discloses, "determining an optimal file format of said data file from a plurality of stored file formats of said data file for use in performing said translation." In the Response to Arguments in the Final Office Action, the response acknowledges the phrase, "of said data file" (Final Office Action: p. 10, lns. 6-7). Specifically, the file conversion driver of Probert (Probert '918: col. 10, ln. 31) which converts the data into a file format while preserving that data, reads on a file format of said data file. Furthermore, since the driver is selected from multiple drivers, each of which convert the data into a file format while preserving that data, this reads on

selecting from a plurality of stored file formats of said data file. (Final Office Action: p. 10, lns. 15-17).

Regarding the missing limitation, "translating the optimal file format of said data file determined in said determining step to the requested file format", this is also covered by Probert which recites, "dynamically converts the information to such a format" (Probert '918: col. 3, ln. 22).

Frantz Coby

FRANTZ COBY
PRIMARY EXAMINER